

November 21, 2003
Case No.: AUS920010172US1 (9000/26)
Serial No.: 09/820,505
Filed: March 29, 2001
Page 8

-- REMARKS --

Claims 1-24 remain under consideration.

Applicants thank the Examiner for the interview of October 30, 2003. In view of the interview, Applicants have amended the claims herein to more particularly point out the invention.

A. Claims 1-2, 4, 6-10, 13-18 and 21 – 24 were rejected under 102(a) as anticipated by Van Den Berghe.

The rejection of claims 1-2, 4, 6-10, 13-18 and 21-24 under 102(a) is traversed. For the claimed invention to be anticipated by Van Den Berghe, each and every element of the claims must be disclosed in the cited prior art in as great detail as claimed. As amended, claims 1, 13 and 21 each require a "browser plug-in" which is not disclosed or taught or suggested by Van Den Berghe. Therefore, Van Den Berghe cannot anticipate claims 1, 13 and 21.

Indeed, Van Den Berghe discloses a shopping cart program that does not operate using a browser plug-in, and requires a Parsing Proxy Server and an Application Server for operation. See, *inter alia*, Abstract of Van Den Berghe and pages 3, and 11-14.

Claims 2, 4, and 6-10 depend from claim 1 and are therefore allowable over Van Den Berghe for at least the same reason as claim 1.

Furthermore, Van Den Berghe does not disclose selectively hiding information regarding at least one of the items, as claimed in claims 4, 15 and 23, and therefore cannot anticipate claims 4, 15, and 23.

Furthermore, Van Den Berghe does not disclose obtaining purchase approval prior to transferring check-out information as claimed in claim 6, and therefore cannot anticipate claim 6.

November 21, 2003
Case No.: AUS920010172US1 (9000/26)
Serial No.: 09/820,505
Filed: March 29, 2001
Page 9

In addition, Van Den Berghe does not disclose configuring the shopping cart according to configuration information received from a user as claimed in claim 7 and therefore cannot anticipate claim 7.

Furthermore, Van Den Berghe does not disclose that the exchanged information includes one or more uniform resource locators (URLs) associated with the checkout of each of the items as claimed in claims 8 and 16 and therefore cannot anticipate claims 8 and 16.

In addition, Van Den Berghe does not disclose that the exchanged information includes an indication of whether the items are to be included during checkout as claimed in claim 9 and therefore cannot anticipate claim 9.

In addition, Van Den Berghe does not disclose retrieving locally stored shopper information for checkout and transferring the locally stored information to the at least one merchant site as claimed in claims 10, 18 and 24 and therefore cannot anticipate claims 10, 18 and 24.

In addition, Van Den Berghe does not disclose means for determining whether the merchant site supports the client shopping card application as claimed in claims 14 and 22 and therefore cannot anticipate claims 14 and 22.

In addition, Van Den Berghe does not disclose that the exchanged information includes an indication of whether the items are to be included during checkout as claimed in claim 17 and therefore cannot anticipate claim 17.

Withdrawal of the rejections to claims 1-2, 4, 6-10, 13-18 and 21-24 is requested.

November 21, 2003
Case No.: AUS920010172US1 (9000/26)
Serial No.: 09/820,505
Filed: March 29, 2001
Page 10

B. Claim 3 was rejected under 103(a) as unpatentable over Van Den Berghe in view of Conklin.

The rejection of claim 3 as unpatentable over Van Den Berghe in view of Conklin is traversed. For this 103(a) rejection to stand, each and every element of claim 3 must be taught or suggested by the references themselves, alone or in combination, in at least as great as detail as claimed. Because Van Den Berghe in view of Conklin fails to teach using a browser plug-in, as claimed in claim 1, the 103(a) rejection must fall.

Claim 3 depends from claim 1, and is therefore allowable over Van Den Berghe in view of Conklin. See MPEP 2143.03 and *In Re Fine* (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

Furthermore, the Examiner failed to point to any motivation or suggestion in the references themselves to modify either Van Den Berghe or Conklin to arrive at the claimed invention. A conclusory allegation that "it would have been obvious to one having ordinary skill in the art at the time the invention was made" entirely fails to provide any evidence. The Examiner should provide evidence in the form of an Examiner's affidavit, or the taking of official notice. However, in this case, the Examiner has taken neither evidentiary step, leaving the record devoid of evidence to support this assertion of obviousness.

Furthermore, the mere fact that the references could be combined to arrive at the claimed invention (which Applicants do not concede) is insufficient to prove a prima facie case of obviousness. See MPEP 2143.01, *In Re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and *In Re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While applicants do not agree that the combination of the references would result in the claimed invention, there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

November 21, 2003
Case No.: AUS920010172US1 (9000/26)
Serial No.: 09/820,505
Filed: March 29, 2001
Page 11

Additionally, as described in the Graham case, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See *Graham v. John Deere Co.*, 383 U.S. 1, (1965). In this case, the Examiner appears to have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness. In view of the fact that the Examiner was entirely unable to support the allegation of obviousness with a citation to either Van Den Berghe or Conklin, the Examiner's use of impermissible hindsight is apparent.

In the absence of any evidence of a motivation to combine, the 103(a) rejections must fall.

Withdrawal of the rejection to claim 3 is requested.

C. Claims 5, 12, and 20 were rejected under 103(a) as unpatentable over Van Den Berghe in view of Franklin.

The rejection of claims 5, 12 and 20 as unpatentable over Van Den Berghe in view of Franklin is traversed. For this 103(a) rejection to stand, each and every element of claims 5, 12 and 20 must be taught or suggested by the references themselves, alone or in combination, in at least as great as detail as claimed. Because Van Den Berghe in view of Franklin fails to teach using a browser plug-in, as claimed in claim 1, the 103(a) rejection must fall.

Claims 5, 12 and 20 depend from claims 1 and 13 and are therefore allowable over Van Den Berghe in view of Conklin. See MPEP 2143.03 and *In Re Fine* (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

November 21, 2003
Case No.: AUS920010172US1 (9000/26)
Serial No.: 09/820,505
Filed: March 29, 2001
Page 12

Furthermore, the mere fact that the references could be combined to arrive at the claimed invention (which Applicants do not concede) is insufficient to prove a prima facie case of obviousness. See MPEP 2143.01, In Re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While applicants do not agree that the combination of the references would result in the claimed invention, there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

Additionally, as described in the Graham case, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See Graham v. John Deere Co., 383 U.S. 1, (1965). In this case, the Examiner appears to have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness. In view of the fact that the Examiner was entirely unable to support the allegation of obviousness with a citation to either Van Den Berghe or Franklin, the Examiner's use of impermissible hindsight is apparent.

In the absence of any evidence of a motivation to combine, the 103(a) rejections must fall. Withdrawal of the rejections to claims 5, 12 and 20 is requested.

D. Claims 11 and 19 were rejected under 103(a) as unpatentable over Van Den Berghe in view of Barr.

The rejection of claims 11 and 19 as unpatentable over Van Den Berghe in view of Barr is traversed. For this 103(a) rejection to stand, each and every element of claims 11 and 19 must be taught or suggested in at least as great detail as claimed by the references, alone or in combination. Because Van Den Berghe in view of Barr fails to teach or suggest at least using a "browser plug-in" as claimed in claims 1 and 13, the rejection must fall.

November 21, 2003
Case No.: AUS920010172US1 (9000/26)
Serial No.: 09/820,505
Filed: March 29, 2001
Page 13

Claims 11 and 19 depend from claims 1 and 13, and are therefore allowable over Van Den Berghe in view of Barr. See MPEP 2143.03 and *In Re Fine* (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

Furthermore, the mere fact that the references could be combined to arrive at the claimed invention (which Applicants do not concede) is insufficient to prove a prima facie case of obviousness. See MPEP 2143.01, *In Re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and *In Re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While applicants do not agree that the combination of the references would result in the claimed invention, there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

Additionally, as described in the Graham case, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See *Graham v. John Deere Co.*, 383 U.S. 1, (1965). In this case, the Examiner appears to have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness. In view of the fact that the Examiner was entirely unable to support the allegation of obviousness with a citation to either Van Den Berghe or Barr, the Examiner's use of impermissible hindsight is apparent.

In the absence of any evidence of a motivation to combine, the 103(a) rejections must fall.

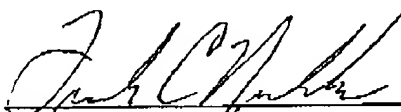
November 21, 2003
Case No.: AUS920010172US1 (9000/26)
Serial No.: 09/820,505
Filed: March 29, 2001
Page 14

CONCLUSION

The Applicants respectfully submit that claims 1-24 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: November 21, 2003

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



Frank C. Nicholas
Registration No. 33,983
Attorney for Applicants